

**REMARKS/ARGUMENTS**

Applicants respectfully request reconsideration of this application in view of the foregoing amendments and the following remarks.

**Claims Status**

Claims 1-20 are pending and rejected. Claims 1 and 7 are independent in form. Claims 1, 2, 4, 7, 8 and 10 are herein amended. The specification has also been amended to correct two inadvertent typographical errors. No new matter has been added by these amendments.

**Double Patenting Rejection under USC § 101:**

Claims 1-16 have been provisionally rejected under 35 U.S.C. §101 as being unpatentable over claims 1-16 of Applicants' co-pending Application No. 09/752,630. The Examiner contends that claims 1-16 in both patents applications are the same. Applicants respectfully disagree with the characterization of both sets of claims proffered by the Examiner.

Further, in a response filed on or about September 19, 2003 to the June 19, 2003 Office Action issued in that co-pending Application No. 09/752,630, Applicants amended claims 1, 3, 5-7, 9, 11-12 therein. Accordingly, Applicants believe that the double patenting rejection is moot and is no longer valid in view of the claim amendments presented in the co-pending application and those presented herein.

**Claim Objections:**

The Examiner objected to claims 2, 4, 8 and 10 due to informalities stated in ¶3 of the Office Action. In ¶4 of the Office Action, the Examiner also indicated that abbreviations for PDN1, PDN2 and BRI should be written out for clarity in the claims.

Claims 2, 4, 8 and 10 are herein amended to address the identified informalities.

However, Applicants respectfully disagree that the use of the stated abbreviations (i.e., PDN1 and PDN2) is unclear. These abbreviations are clearly defined with reference to the specification and are readily understood by those skilled in the art. Nonetheless, to expedite prosecution, abbreviations of PDN1, PDN2 and BRI are expanded and defined in claims 1 and 7.

Accordingly, Applicants believe the claim amendments overcome the stated objections and request that the objections be withdrawn.

**Claim Rejections under 35 USC § 112:**

In ¶5 of the Office Action, the Examiner rejects claims 1, 3, 7 and 9 for lack of sufficient antecedent basis for the limitation "the message exchange" recited in those claims. Claims 1 and 7 are herein accordingly amended so as to correct the cited deficiency. Applicants believe this rejection is overcome and request that it be withdrawn.

**Rejection of Independent Claims 1 and 7 under 35 USC § 102(b):**

Independent claims 1 and 7 have been rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 4,907,259 to Frech. The dependent claims have been rejected as stated on pages 3 through 7 of the Office Action.

The Examiner has taken the position that Frech teaches a method for identifying Call Appearance (CA) values in a Private Branch Exchange (PBX) device coupled to multiple ISDN Basic Rate Interfaces (BRIs) by generating a first call from a first Primary Directory Number (PDN1) to a second Primary Directory Number (PDN2) in the same BRI circuit and by monitoring the message exchange on the D Channel to obtain Call Appearance information for each BRI coupled to the PBX device. Applicants respectfully disagree.

Frech is directed to a method for providing ISDN users flexibility in controlling originating and terminating calls at multiple Call Appearances of a given directory number. Frech teaches a Call Appearance reservation arrangement in which a reservation type for each Call Appearance is designated as "origination only", "termination only" or as "origination and priority termination only." Frech does not address identifying or obtaining Call Appearance values between Primary Directory Numbers in an ISDN BRI circuit, nor does it teach or suggest the step of generating calls between the two primary directory numbers of an ISDN BRI circuit, or the additional step of monitoring the D Channel for the purpose of identifying or obtaining Call Appearance values as claimed.

On the other hand, the present invention as recited in independent claims 1 and 7 permits automatic identification of and obtaining Call Appearance values for Primary Directory Numbers (PDN's) in a PBX device coupled to a plurality of ISDN BRIs. A claimed method of the present invention comprises, *inter alia*, the steps of generating calls from a first Primary Directory Number (PDN1) to a second Primary Directory Number (PDN2) and monitoring the message exchange (on the D channel) to obtain Call Appearance values for Call Appearances associated with the Primary Directory Numbers. Accordingly, Applicants respectfully disagree

with the Examiner's assertion that the method and system of the present invention are anticipated by, or for that matter even suggested by, the teachings of Frech.

Specifically, it is alleged that Frech teaches generating a first call from PDN1 to PDN2 in the same BRI circuit in col. 4, lines 60-67, col.5 lines 1-10, 53-67 and col. 6, lines 1-36 thereof. See ¶7 of the Office Action. Applicants respectfully disagree with this characterization and believe that Frech, in particular the cited portions indicated by the Examiner, does not teach or suggest at least the claimed element of generating a first call from PDN1 to PDN2 in the same BRI circuit coupled to a PBX, as the Examiner contends. Applicants respectfully submit that the cited sections of Frech, in contrast to the alleged teachings attributed thereto, discuss rather, obtaining a definition of Call Appearance types for a given call, when the call originates or terminates at the ISDN terminal. There is no indication anywhere in Frech that a call is initiated between two Primary Directory Numbers in an ISDN BRI for the purpose of obtaining Call Appearances. In Frech, call originating or terminations refer to calls received in a typical use of the ISDN terminal whereas in the present invention the method is initiated automatically as part of the self configuration of the ISDN terminal.

The Examiner, with reference to col. 3, lines 5-9, col.4 lines 60-67, col. 5, lines 1-10, 53-67 and col. 6, lines 1-36 thereof, also alleges that Frech teaches monitoring the message exchange on the D Channel to obtain first Call Appearance information. See ¶7 of the Office Action. Again, Applicants respectfully disagree and believe that the cited sections in Frech do not teach or suggest the claimed element of monitoring the message exchange on the D Channel for the purpose of obtaining the first Call Appearance information. Instead, Frech teaches obtaining the reservation type of a Call Appearance (i.e., origination only, termination only or as origination and priority termination only) which is different than the claimed monitor feature.

Therefore, Applicants respectfully submit that at least the steps of (a) generating a first call from PDN1 to PDN2 in the same BRI circuit of a PBX and (b) monitoring the message exchange on the D Channel to obtain the first Call Appearance information, do not exist in Frech, individually and much less so in the claimed combination. The automatic identification of Call Appearance values in a PBX employing ISDN BRIs that is introduced by the present invention is not addressed in Frech, and the claimed method and/or apparatus of the present invention simply do not exist, and therefore are not taught or suggested, in Frech.

Therefore, Applicants believe that the present invention as claimed is not within the teachings of Frech and is patentably distinct therefrom for at least these reasons.

Nonetheless, Applicants have amended independent claims 1 and 7 to specifically clarify the claimed method and apparatus and explicitly specify the foregoing functionality. Applicants believe that the invention as recited in amended independent claims 1 and 7 is patentable over the cited art because Frech does not teach, disclose or suggest, individually or in combination with other references of record, at least the foregoing aspects of the claimed invention.

**Dependent Claims**

Applicants have not independently addressed the rejections of the dependent claims 2-6 and 8-20 because Applicants believe that, as the independent claims 1 and 7 from which the dependent claims depend are allowable for at least those reasons discussed *supra*, the dependent claims are allowable for at least similar reasons. Applicants however, reserve the right to address such rejections should such be necessary and appropriate.

Based on the foregoing, Applicants respectfully submit that the inventions as recited in the claims 1-20 as presented herein are neither anticipated by nor rendered obvious in view of, and are therefore allowable over, the art of record, taken alone or in combination and respectfully request that the respective rejections and objections be withdrawn.

**CONCLUSION**

All rejections/objections of claims having been addressed and the claims as presented herein being believed allowable, Applicants submit that the application is hereby placed in condition for allowance. Accordingly, Applicants respectfully request reconsideration and allowance of this application.

Applicants believe no fees or additional extension of time are required for this Amendment. However, should an additional extension of time be required for the timely submission of this paper, such extension is hereby petitioned and the Commissioner is hereby authorized to charge any additional fees which may be required for this paper, or credit any overpayment, to Deposit Account No. 19-2179.

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In the event that a telephone conference would facilitate prosecution, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,

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